

REMARKS

The present application was filed on March 29, 2001 with claims 1-17. Claims 1-17 are currently pending in the present application. The present application claims the priority of U.S. Patent Application Serial No. 08/977,382 filed November 24, 1997.

In the Office Action mailed July 2, 2002, the Examiner rejected claims 1, 2, 5, 6, 9, 10, 13, 14 and 17 under 35 U.S.C. §102(b) as being anticipated by Sarbadhikari et al. (U.S. Patent No. 5,477,264), rejected claims 3, 4, 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Sarbadhikari et al. in view of Fellegara et al. (U.S. Patent No. 5,845,166), and rejected claims 7, 8, 15 and 16 under §103(a) as being unpatentable over Sarbadhikari et al. in view of Smart et al. (U.S. Patent No. 6,147,744).

In this response, Applicants amend independent claims 1 and 10, and traverse the §102(b) and §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

Applicants initially note that the Fellegara et al. and Smart et al. references utilized by the Examiner in formulating the §103(a) rejections are commonly assigned with the present application. Moreover, the present application, as a continuation application filed on March 29, 2001, is entitled to the benefit of 35 U.S.C. §103(c).

The subject matter of the Fellegara et al. reference and the claimed invention were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. Therefore, Applicants submit that the Fellegara et al. reference, which issued December 1, 1998, after the November 24, 1997 priority date of the present application, is not available as prior art in a §103(a) rejection of the present application. See MPEP §706.02(I).

With regard to the Smart et al. reference, it was filed on December 28, 1998, after the November 24, 1997 priority date of the present application, and is therefore also not available as prior art.

The §103(a) rejections based on Fellegara et al. and Smart et al. are therefore believed to be improper and should be withdrawn.

With regard to the §102(b) rejection, Applicants traverse the rejection on the ground that Sarbadhikari et al. does not disclose at least the claimed print utilization file as set forth in independent claims 1 and 10. The Examiner in the §102(b) rejection argues that the claimed print utilization file is disclosed in column 4, lines 37-42 of Sarbadhikari et al. However, this portion of the Sarbadhikari et al. reference does not disclose a print utilization file that identifies "at least two digital image files . . . to be printed" as set forth in claims 1 and 10.

Notwithstanding this traversal, Applicants have amended independent claims 1 and 10 to clarify that the "at least two digital image files" associated with the claimed print utilization file correspond to "selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card." Support for the amendment can be found in the specification at, for example, page 3, lines 3-16 and page 3, line 32 to page 4, line 9.

Applicants respectfully submit that independent claims 1 and 10 as amended are not taught or suggested by the Sarbadhikari et al. reference. The §102(b) rejection should therefore be withdrawn.

Dependent claims 2-9 and 11-17 are believed allowable for at least the reasons identified above with regard to their corresponding independent claims.

Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claim 1 has been amended as set forth below.

1. (Once amended) An electronic printing system for printing images stored on a removable memory card, the electronic printing system comprising:

(a) a memory card interface for receiving the removable memory card, the removable memory card having stored thereon a plurality of digital image files and a print utilization file, the print utilization file [including the names of] identifying at least two digital image files stored on the removable memory card to be printed, the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card;

(b) a processor coupled to the memory card interface for reading the print utilization file stored on the removable memory card and the digital image files identified in the print utilization file; and

(c) a print engine coupled to the processor for producing prints of the at least two stored digital image files identified in the print utilization file.

Claim 10 has been amended as set forth below.

10. (Once amended) A method for printing images stored on a removable memory card, the method comprising the steps of:

(a) providing a removable memory card having stored thereon a plurality of digital image files and a print utilization file, the print utilization file identifying at least two digital image files stored on the removable memory card to be printed, the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card;

(b) reading the print utilization file stored on the removable memory card and the digital image files identified in the print utilization file; and

(c) producing prints of the at least two stored digital image files identified in the print utilization file.